

REMARKS

In the Final Office Action of August 9, 2006, the Examiner (1) required cancellation of claims 18-21; (2) objected to the drawings and asserted that FIG. 1 should be labeled prior art; (3) objected to the drawings showing the plurality of openings from the at least one bullet stop; (4) rejected claims 1-3, 5, 7-17 and 22-30 under 35 U.S.C. § 112, ¶ 1; (5) rejected claims 1, 2, 3, 5, 13, 22, 24, 25 and 29 under 35 U.S.C. § 102; and (6) rejected claims 1, 5, 7-17 and 23 under 35 U.S.C. § 103. Applicant has canceled claims 18-21 and traverses the remaining objections.

FIG. 1 should not be labeled prior art

The Examiner mistakenly asserts that FIG. 1 should be labeled prior art. Applicant respectfully disagrees. The Examiner has apparently misread paragraph 30 of the specification. Specifically paragraph 30 includes the following sentence: "Referring to FIG. 1, there is shown a side cross-sectional view of a bullet stop and containment chamber, generally indicated at 10, in accordance with the principles of the prior art." However, the bullet stop and containment chamber - which is well known in the art - is only a portion of FIG. 1. Specifically, FIG. 1 also includes a "housing 86 which forms a transport tube for collecting projectiles which have been fired into the bullet stop and containment chamber 10" and an "an elongate screw 90 which forms a worm drive or screw conveyor for moving bullets and bullet fragments to one end of the housing." (Paragraphs 32-33). It is clear throughout the specification that inclusion of a screw drive to move bullets and bullet fragments is a principle aspect of the invention. (See Paragraphs 19-20, 38, 41, etc.). Thus, Applicant respectfully declines to mark FIG. 1 as prior art.

The Drawings Show Every Feature of the Claims

The drawings clearly show each feature of the claims. The drawings show bullet stop and containment chambers 10 and 110. These structures are repeatedly called bullet stop and

containment chambers, and are even referred to in a similar manner in the prior art cited by the Examiner.

Likewise, the drawings show a plurality of outlets 112 in both FIG. 2 and FIG. 3. Thus, the rejection should be withdrawn.

The claims comply with the written description requirement of 35 U.S.C. § 112

The Examiner asserts that the specification does not provide adequate support for a chamber which is capable of stopping or containing a bullet. Furthermore, the Examiner asserts that “stop should be interpreted as ‘ceasing all movement’ and to contain should be interpreted as ‘keeping within limits.’ The Examiner, however, provides no basis for his interpretation. Furthermore, the very art which the Examiner cites is inconsistent with his interpretation.

On first impression, the Examiner’s position that there is no support for “bullet stop and containment chamber” is odd in that the phrase is used to describe a structure that receives and decelerates a bullet repeatedly throughout the specification. (See paragraphs 30, 32, 34, 36, 38, 39, 42-44, 46 and 47). Moreover, as the phrase is used repeatedly throughout the specification, the proposed interpretation by the Examiner is clearly erroneous if the structure so described would not function in accordance with the Examiner’s interpretation and no person of ordinary skill in the art would give such an interpretation to the phrase. Such as been repeatedly recognized by the United State Court of Appeals for the Federal Circuit. “A patent claim should be construed to encompass at least one disclosed embodiment in the written description portion of the patent specification”. *Johns Hopkins Univ. v. Cellpro, Inc.* 152 F.3d 1342 (Fed. Cir. 1998). “We share the district court’s view that it is unlikely that an inventor would define the invention in a way that excluded the preferred embodiment, or that persons of skill in this field would read the specification in such a way.” *Hoechst Celanese Corp. v. BP Chemicals*, 78 F.3d 1575, 1581 (Fed. Cir. 1996)(citing *Modine Mfg. Co. v. United States Int’l Trade Comm’n*, 75

F.3d 1545, 1550 (Fed. Cir. 1996)

In the present case, the phrase bullet stop and containment chamber is used repeatedly to describe a chamber with an inlet, a deceleration area, and an outlet. Thus, one of ordinary skill in the art would understand the terminology used. The chamber stops the forward progression of the bullet and contains any bullet fragments.

Additionally, the Examiner provides no support for his definition. Stop is defined much more broadly than the Examiner proposes. To stop means “to cut off, intercept, or withhold”, “to restrain, hinder, or prevent”, “to prevent from proceeding”, “to block, obstruct or close”. See Dictionary.com. Thus, there are numerous interpretations of stop other than that raised by the Examiner. As the Examiner has failed to demonstrate why one of skill in the art would understand the term in accordance with his interpretation, the rejection under section 112 should be withdrawn.

Likewise, the definition of containment is broader than that asserted by the Examiner. Contain can mean “to hold or keep within limits” or “to halt the spread of development of”. The chamber holds, keeps within limits and halts the spread of bullet fragments as the bullet decelerates.

The structure is referred to as a bullet stop because it stops the forward momentum of the bullet. It is referred to as a containment chamber because it contains the bullet and fragments thereof. It also contains lead dust generated while decelerating the bullet. One of skill in the art will appreciate that some bullets will come to a complete stop within the chamber prior to sliding or being pushed by subsequently fired rounds, down into the collection system, while all bullets will stop their initial forward movement along which they were projected.

Ironically, the very art on which the Examiner relies actually discounts his interpretation. Bateman '662 shows a containment chamber which is very similar to that shown in the present

application and described as a bullet stop and containment chamber. The title of Bateman '662 is "Bullet Stop and Containment Chamber." Furthermore, the Abstract provides:

A bullet stop and containment chamber for stopping the forward momentum of projectiles traveling in a generally horizontal zone of projectile travel. The bullet enters the wide end of a channel having plates which guide the bullet into a narrow opening which leads into a containment chamber. The containment chamber has a series of plates arranged with increasing angles of incidence such that the sequential impacts are increasingly direct. There are also side plates on the chamber which combine with the other structure to confine bullets, fragments and particulate matter to the chamber until inertial momentum is arrested and the bullet drops out of an egress. (Emphasis added).

In the Field of the Invention, Bateman '662 describes its invention of a bullet stop and containment chamber as follows: "The present invention relates generally to apparatus for deceleration of projectiles, and containment of those projectiles and their fragments and particulate resulting therefrom." (Col. 1, lines 9-12).

The difference between a simple bullet stop and a bullet stop and containment chamber is also obvious from Bateman '662. "Simple barriers and fixtures may stop a projectile, but allow lead fragments or particulate to escape into the environment." (Col. 1, lines 53-55).

Moreover, Bateman '662 makes clear that bullet stops are not limited to the particular structure shown and claimed in that patent. In discussing Coburn U.S. Pat. No. 5,070,763, Bateman '662 discusses bullet stops having containment chambers with curved portions. (Col. 3, lines 23-39). In Coburn '763, the bullet is directed into an inlet, decelerated in a generally circular chamber, and then rolls or slides out of the chamber and falls into a collection area. Coburn describes his invention as follows: "This invention relates to bullet traps, i.e., devices used to catch and stop bullets fired from rifles, shotguns, handguns, and the like in a firearm testing facility or a commercial firing range." (Col. 1, lines 4-7). A bullet stop and containment

chamber is any chamber with stops the forward movement of a projectile until the inertial momentum is arrested and which contains bullet fragments.

Thus, the primary reference relied on by the Examiner in rejecting the claims, along with art cited therein, shows that the Examiner's requirement that the bullet come to a complete rest within the chamber is erroneous.

Likewise, the other references relied upon by the Examiner are inconsistent with his interpretation. Lambert teaches the use of a containment chamber (See e.g. paragraph 53) which has an inlet and an outlet. The paragraph immediately after that cited by the Examiner for his Section 103 rejection states:

[0091] When a bullet is fired at the bullet trap 200 it will initially impact one of the channeling plates 212 or 216. The bullet will then ricochet one or more times until it enters the aperture 220 of the bullet containment chamber 208. Once in the bullet containment chamber, the bullet will ricochet or slide to a stop along the generally circular walls of the bullet containment chamber and fall through the egress 228. The bullet will then enter the bullet disposal chamber, where it will rest in the bucket 240 or be moved by the disposal system 244.

Clearly, Lambert is not referring to the cessation of all movement of the bullet when he discusses the bullet being slowed to a stop and falling through the egress. Thus, the Examiner's interpretation of bullet stop and containment chamber is in error.

Likewise, Sovine '980 uses the phrase in the same manner as the present application. Throughout his Application, Sovine discusses a bullet stop and containment chamber in a manner consistent with that used by Applicant. Sovine also shows a chamber with an inlet and an egress. Sovine notes:

The present invention relates to a system for retrieval of projectiles fired into a **bullet stop and containment chamber**. More particularly, the present invention relates to a system which removes bullets and bullet fragments from a series of containment chambers or an elongate chamber more conveniently and with less

environmental exposure to the lead of the bullets. (Col. 1, lines 5-11, Emphasis Added).

The use of the term bullet stop and deceleration chamber is not unique to the prior art cited by the Examiner. For example, Larsen et al., U.S. Patent No. 6,837,496 discusses bullet containment systems as follows:

Thus, current trends in bullet containment systems focus on two different types of systems. The first, **often called a bullet stop and containment chamber**, has a pair of plates that channel bullets toward an opening in a containment chamber. Inside the containment chamber are impact plates that slow the bullet to a stop. Unfortunately, such systems are relatively expensive and difficult to manufacture and maintain. (Col. 1, lines 38-45, Emphasis Added).

Thus, Applicant submits that one of ordinary skill in the art would understand that the claim language means that a structure is provided which stops the forward momentum of the bullet and contains fragments and lead created by decelerating the bullet. He or she would not believe that the bullet must cease all movement in the chamber as asserted by the Examiner, any more than a backstop causes a complete cessation in the movement of a baseball.

Finally, the Examiner's interpretation is erroneous with respect to FIG. 3 because control members are used to selectively prevent bullets from passing into the transport tube. See Paragraphs 42-44. If the control member were closed, the bullets would stop and back up in the opening 112 and containment chamber.

Claims 24-29 comply with the written description requirement

Applicant respectfully disagrees with the Examiner's assertion that claim 24 as previously present violates Section 112, paragraph 1. FIG. 3 shows at least one bullet stop and containment chamber and a plurality of outlets for releasing the bullets from the at least one chamber. Of course, at least one chamber can include more than one chamber. FIG. 3 shows a plurality of chambers and a plurality of outlets. However, to expedite allowance of the case,

Applicant has amended claim 24 and a few dependent claims in accordance with the Examiner's suggestion. Thus, it is requested that the amended claim be entered.

Claim 26 is supported by the specification and drawings

The Examiner asserts that claim 26 violates 35 U.S.C. § 112, ¶ 1, because neither the specification nor the drawings teach a plurality of outlets comprising a plurality of funnels. Applicant respectfully directs the Examiner to FIGs. 2 and 3, where outlets 112 are shown as funnels.

Claim 28 is supported by the specification

The Examiner also objects to claim 28 on the assertion that "Neither the specification nor the drawings describe the vacuum system as being parts of the transport mechanism (i.e. transporting projectiles)." First the Examiner's definition of the transport mechanism is unduly narrow. Nothing says that the transport mechanism transports only projectiles. Furthermore, both the specification and the drawings teach that the vacuum is attached to the housing which forms the transport tube. See FIG. 3 and paragraphs 46-47. The specification clearly teaches that the vacuum transport lead dust through the housing along the elongate screw.

The rejections under 35 U.S.C. § 102 should be withdrawn

The Examiner's rejection under section 102 is improper. The specification only indicates that a portion of the drawing, namely the bullet stop and containment chamber, is prior art. Nowhere does the Applicant admit that the screw drive is prior art. To the contrary, the screw drive is discussed repeatedly as being an aspect of the invention.

Furthermore, the Examiner's raising of this new rejection in a final office action is questionable. If the FIG. 1 anticipates the current claims, it would also have anticipated the prior claims. Thus, the rejection should have been made earlier, not in a final office action.

The rejections under 35 U.S.C. § 103 should be withdrawn

The Examiner's rejections should be withdrawn, as each fails to make a proper case of obviousness.

First, the rejection of claims 1, 5, 11, 12, 13, 14, 17, and 23 should be withdrawn. The Examiner asserts that these claims are obvious in light of Bateman '662 and the Lambert et al. publication. Applicant notes that the filing date of the Lambert nonprovisional application (the basis of the rejection) is after the priority date of the provisional in the present application. Thus, the teachings of the Lambert nonprovisional case can only serve as a basis for rejecting subject matter which was added after the filing date of the provisional application. The Examiner has made no showing that any of the claimed subject matter was added after the filing date of the Lambert et al. nonprovisional application. Thus, the Lambert et al. nonprovisional application cannot serve as a basis to reject the claims.

If the Examiner wishes to reject the presently pending claims, he would be required to rely on the Lambert et al. provisional. The Examiner, however, has failed to cite the provisional application and has not provided either a copy of the provisional or an analysis of why it would render the presently pending claims obvious.

Thus, unless the Examiner has shown that the rejection relates to material added in the present application, the Lambert publication is not a proper reference under Section 103. Rather, the Examiner would be required to rely on the provisional application of Lambert, as any material added to Lambert after Applicants' effective priority date would be an improper basis for rejection. As the Examiner has not cited or provided a copy of the Lambert et al. provisional, the rejection should be withdrawn.

Additionally, while the Examiner rejected the evidence that the two applications are both assigned to Action Target because the assignments were not for the provisional, it is noted that

section 103(C) only requires that there be an obligation to assign - not that the assignment have already taken place. To resolve any disputes on the matter, Applicant provides the declaration of Kyle Bateman, the President of Action Target and an inventor on both cases evidencing that 1) there was a duty to assign both applications to Action Target, and 2) that the invention described in the present application was created prior to the filing date of both the nonprovisional and the provisional applications for Lambert et al. Thus, the rejections under section 103 should be withdrawn.

While the Examiner has refused consideration of the Bateman Declaration on the basis that the affidavit was filed after the filing of a Notice of Appeal, this is clearly incorrect. Applicant has yet to file a Notice of Appeal in this case and the provision of #9 on the cover sheet is inapplicable.

The Declaration was filed after the Final Office Action. However, this was to respond to a new argument raised by the Examiner in the Final Office Action. Applicants had previously noted that the present application and the published Lambert application were both assigned to Action Target, Inc. In response, the Examiner raised Applicants' provisional application, and asserted that section 103(C) was not applicable because the Applicants' provisional application was not assigned to Action Target. The Bateman Declaration is responsive to the Examiner's argument and was not submitted earlier because the Examiner had not previously attempted to rely on the provisional. Thus, a declaration demonstrating that section 103(C) was applicable should be considered by the Examiner.

The Examiner's argument shows an inherent inconsistency in the examination. On the one hand, the Examiner attempted to rely on the filing of the provisional application as a basis for asserting that section 103(C) did not apply. On the other hand, the Examiner is citing as prior art the publication of a patent application filed after the filing date of the provisional.

Either way, the Final Office Action was improper - as Lambert et al is not prior art.

Likewise, the rejection of claims 7-10 and 15-16 should be withdrawn. The Lambert et al. publication is not a legitimate basis for rejecting the claims per 35 U.S.C. § 103(C), or under section 102, as the application was filed after the filing date of Applicants' provisional. If the Examiner wishes to rely on Lambert et al. to reject the claims, he must base the rejection on the provisional application - thus requiring a new office action. In the process, he must also consider the Bateman Declaration, demonstrating that even the Lambert et al. provisional is not prior art.

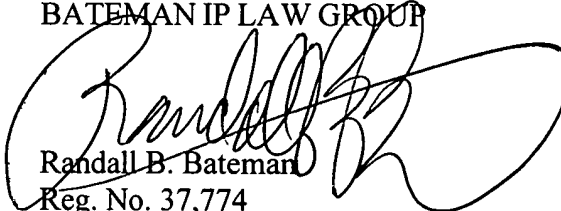
Conclusion

Applicant has submitted amendments and arguments to place the application in condition for allowance.

Should the Examiner determine that adverse action is necessary, it is requested that he contact Applicant's attorney, Randall B. Bateman, at (801) 533-0320 so that such matters may be resolved as expeditiously as possible.

The Commissioner is hereby authorized during the entire pendency of application to credit any overpayment and debit any amount owing, including fees for extensions of time, to Deposit Account No. 50-2720.

Respectfully Submitted,
BATEMAN IP LAW GROUP

A large, stylized handwritten signature in black ink, appearing to read 'Randall B. Bateman', is written over the printed name and registration number.

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